

Remarks/Arguments

This amendment is in response to the Office Action dated December 8, 2003.

Claims 1-6, 10, 11, 16, 24, 26 and 27 remain in this application. Claim 12 has been canceled.

The proposed drawing for Figure 11 has been accepted.

The drawings filed on 2/10/03 and 7/17/03 have been objected to as they fail to show the features claimed by claims 5 and 6. Applicant asks that this objection be withdrawn.

On May 5, 2002 the Examiner made the same objection. An amendment to the drawings, namely to add Figure 9 was made on July 19, 2002 to overcome this rejection. That amendment to Figure 9 was accepted by the examiner in the office action dated October 24, 2002. Formal drawings including the accepted addition of Figure 9 were submitted on January 31, 2003 and received by the Office on February 10, 2003 as indicated by the return receipt card in Applicants file. As such it is believed that the present objection has already been addressed and the correction accepted by the Examiner and as such the present objection is not necessary or proper.

Before addressing the specific rejection of the claims in the Office action Applicant wishes to address the improper interpretation used by the Examiner in determining the scope of the claims and the prior art. In particular Applicant believes the interpretation used by the Examiner for the term "skive" is incorrect, improper in view of its use in the present application and has led to an unnecessary and erroneous office action rather than an allowance. As defined by the Examiner at paragraph 6 of the present office action "the term "skive" has been defined and considered by the examiner to mean any structure which forms an interlock or preventing movement of a filter away from the bottom or a mechanical structure which retains the filter within the well".

Applicant disagrees with this definition and believe it is unwarranted and unsupported.

The definition as used by the examiner would include glues, solvent bonds, thermal bonds and other chemical or non-mechanical means as well as mechanical means such as c-clips, o-rings, undercuts and the like.

Yet the language of the claims and the specification makes it clear that the filter is held by a specific type of mechanical interlock, namely a skive.

Note for example, claim 1 which limits the holding of a filter to the bottom of a well by first a "mechanical interlock" and then defining that interlock as being "one or more skives". Likewise note the same language used in Claims 26 and 27.

It is clear that Applicant has limited his invention to a particular type of a mechanical interlock, namely a skive for holding the filter against the bottom of the well.

A skive as has been stated previously and as is recognized in paragraph 30 of the present office action is a continuous roll of inner wall material that is used as a mechanical interlock to hold a filter piece or pieces in place with the well.

The broader interpretation proposed by the examiner is clearly unsupported by the claims themselves as well as the present specification.

Applicant believes the rejections predicated upon this erroneous definition should be withdrawn as improper, inappropriate and contrary to the plain and precise meanings of the claims and the teachings of the present application.

In the event that Applicant's request for withdrawal of the erroneous based action, Applicant has responded to the current rejections as follows.

Claims 1-3 and 10 have been rejected under 35 USC 102(b) by US 5,715,741 (Gasser et al).

Applicant disagrees.

Gasser et. al. uses an injection molded frame 4 around the edges of a filter base plate 2 so as to bond the frame to the pot wall 1. It relies upon a bond of a separately injection molded piece of plastic between the frame and the pot to hold the filter base in place. In all but one example it uses both a top as well as a bottom piece to surround the opening of the pot and secure the base in place. Only in Figure 11 is the bond above the bottom opening of the pot. Even there, the plastic still surrounds the filter plate on both sides (something that is not required or possible with the present claimed invention and something that occurs in all embodiments of the Gasser et.al. reference) and it further relies on undercuts formed in the wall of the pot into which injection molded plastic flows to form a secure hold.

This quite unlike the present invention which requires a specific species of mechanical interlock be used against the top of the filter to secure the filter against the bottom of the well, namely a skive. Gasser et. al. fails to teach the specific mechanical interlock required by the claims, namely a skive. Moreover the means taught by Gasser et.al. would not be interpreted by one of ordinary skill in the art to be a "skive" as defined by the present claims and specification. Additionally, it does not form its locking mechanism only against the top of the filter but rather on both sides (top and bottom) and through it.

Applicant reiterates his argument above that the examiner has applied a too broad and improper definition to the term skive, one that is unsupported by the case and one which fails to be taught by the cited reference.

As such Applicant believes the 102 rejection is improper as the reference fails to teach each and every claimed element of the present invention.

Claims 4, 11, 12, and 24 have been rejected under 35 USC 103(a) over Gasser et. al.

The office action states the limitation "about 7 degrees " is indefinite. It is believed that this assertion which is a 35 USC 112 rejection is improper in a 103(a) rejection and if it wa to be made if at all, it should be done a separate rejection based on 35 USC 112, 35 USC 103(a). Withdrawal of this rejection on the fact that it at least in part is based upon an unasserted basis is requested.

Moreover, the use of the term "about" is well-known, accepted and allowed by the case law. See, Eigelstein v. Frank, 34 USPQ2d,1467 (Fed Cir 1995); Modine Mfg Co v. United States Int'l Trade Commission , 75 F3d 1545 (Fed Cir 1996). Applicant believes that the use of the term in this claim is clear and unambiguous to one of ordinary skill in the art and would not be interpreted as has been done by the present office action.

Applicant objects to the assertion used in this rejection that the reference, in Figure 9, shows an inner wall taper of less than 10 degrees, more specifically "about 6 to 8 degrees". It is well established from the case law that patent drawings are not accurate, are not to scale and are not to be relied upon form specific measurements unless they are clearly shown or described in the figure or the accompanying text. See In Re Klein, 26 USPQ2d 1133 (Fed Cir 1993). As no such information exists in the cited reference, it is believed that this rejection is improper and should be withdrawn.

A to claim 11, Applicant disagrees with the assertion that it would have been obvious to use a plastic filter as claimed in lieu of the metal filter of the reference as such a plastic filter would be lighter in weight and less likely to corrode. Yet the reference makes it perfectly clear that the filter must be

made of metal. This is a clear teaching away from the suggestion of obviousness asserted by the examiner, especially in view of the use of plastic in the frame of the reference. Clearly the reference knew of plastics but not only didn't suggest the use of them in the filter, required it be made of metal. To suggest that one use a plastic filter as claimed by citing a reference that clearly requires the use of a metal filter is improper and contrary to what one of ordinary skill in the art would consider in reviewing the teaching and suggestions of the reference.

As to claim 24, the reference fails to teach or suggest the one of one or more pieces on top of each other in the well. It would be contrary to the teachings of the reference to do so. The reference relates to an espresso filter cup and it contains several specific suggestions as to the filter opening designs and the thickness of the filter that lead to one obtaining the desired product. It would not have been obvious to add layers of additional filter as that would detract the optimum product that is desired. Multiple parts would not lead to a multiplied effect in the reference, but most likely a deleterious effect. As such claim 24 would not have been obvious from the cited reference to one of ordinary skill in the art.

Claims 1, 5, 6, 10, 11, 16 24, and 26 have been rejected under 35 USC 103 (a) over Zermani in view of DeSalvo. Applicant disagrees.

Claim 1 is considered by the examiner to be a product by process claim due to its use of the term "skive". Applicant disagrees and points to recent case law that again reinforces that terms may be used that provide a structural element rather than a process limitation and do not render a claim a product by process claim unless demonstrated otherwise; see 3M Innovative Properties Co. v. Avery Dennison Corp., Slip Opinion No. 03-1203, December 2, 2003. As pointed out by the opinion, even words of limitation that can equally connote structure or process are commonly and by default

interpreted in their structural sense unless demonstrated otherwise, citing Hanzai V. United States International Trade Commission, 126 F.3d 1473 (Fed Cir 1997) and Vanguard Prods. Co. v. Parker Hannifin Corp., 234 F.3d 1370 (Fed Cir 2000). Applicant believes the same applies here. Moreover, the term "skive" is a noun and is a specific type of mechanical interlock formed of a continuous roll of the inner wall of the well. As such, it is believed that the assertion that the use of this term creates a product by process claim is incorrect and contrary to the case law.

Moreover, Zermani applies a heat seal to the bottom surface of the filter. It does not form a mechanical interlock in the form of a skive to the top surface of the filter as claimed. As such it fails to teach or suggest the present invention.

DeSalvo doesn't overcome the problems of Zermani for DeSalvo does not teach or suggest the formation of a skive, but rather a crimp. It would not have been obvious from the cited combination to use a skive (as properly interpreted) to hold the top of a filter in place.

Zermani has been argued to teach an outwardly tapering wall in its Figure 6. However, when reads the description of Figure 6 of Zermani one finds that the area 29 is in fact an undercut and not a tapered wall as currently claimed.

It would not have been obvious from the cited combination to use a skive (as properly interpreted) to hold the top of a filter made from polymeric materials in place as in claim 10 for the reasons stated above.

While Zermani may teach the use of plastic filter materials and a different number of wells, it alone or in combination with DeSalvo fails to teach the use of a skive to hold the top of a filter in place.

While Zermani may teach the use of several pieces of filter on top of each other, it states that only the bottom piece must be sealed, although it is preferable all are. Even then, as taught by Zermani, it is the bottom surfaces of the filter that are sealed to the bottom surface or each other, not the top surface as in the present claims.

The arguments applied to claim 1 apply to claim 26 as well and are incorporated herein by reference.

Claims 2-4 are rejected under 35 USC 35 103 (a) over Zermani in view of DeSalvo in further view of Cohen et.al.. Claims 2-4 are stated to lack proper antecedent basis through the use of the term "the" before vertical center line. Applicant notes that these claims use the term "a" and therefore the apparent 35 USC 112 rejection is both unnecessary and improper.

Cohen et.al. contrary to the examiner's assertion does not use a portion of the inner wall of the well 46 to create a mechanical interlock. As is clear in the reference, the use of the bottom of the top block 44 recess 36b and gaskets 54 and 56, all spaced outwardly from the inner wall of the well create the mechanical interlock. As such the cited combination fails to teach the invention of claims 2-4. Moreover, as amended the claims are not suggested by the cited combination in which a taper at best occurs in only part of the well.

Reconsideration and allowance of the remaining claims is respectfully requested in view of the foregoing amendment and remarks.

Respectfully submitted,



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